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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,005	09/21/2000	Tomotoshi Sato	49986-0500	8312
29989	7590	09/17/2004	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125			HUTTON JR, WILLIAM D	
		ART UNIT	PAPER NUMBER	
		2179		

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/668,005	SATO, TOMOTOSHI 
Examiner	Art Unit	
Doug Hutton	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-76 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-76 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 20 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

In Applicant's Response dated 19 April 2004, Applicant submitted new formal drawings, amended Claim 28, added new Claims 29-76, and argued against all objections and rejections previously set forth in the Office Action dated 28 January 2004.

The objection to the drawings is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 and 14-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al., U.S. Patent Application Publication US 2003/0140315 A1.

Claim 1:

Blumberg discloses a method for previewing an electronic document (see Page 1, Paragraph 0009), the method comprising:

- generating the electronic document at a client (see Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – a user creates a document using a typical word processor);
- transmitting document information associated with the electronic document from the client to a printing device (see Figure 2; see Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – the user imports the document into Virtual Builder; thus, the referenced invention “transmits” “document information” to a “printing device”; Virtual Builder is a “printing device” in that it can be on a print server that is connected to a printer, as shown in Figure 2);
- generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client (see Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – Virtual Builder allows the user to preview the finished document based on the “document information” and “specific characteristics” associated with Virtual Builder in that it allows the user to load a document, which includes “document information,” and select various finishing options that are not available at the client; see the various options in Paragraphs 0067-0071 for examples of “specific characteristics” that are “unavailable at the client”);
- transmitting the preview document data to the client from the printing device (see Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – the user views the print preview at the client computer); and

- previewing the electronic document at the client based on the preview document data received from the printing device (Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – the user views the print preview at the client computer).

Claim 2:

Blumberg discloses the method of Claim 1, wherein:

- the printing device is a multi-functional printer (MFP) (Virtual Builder is a “multi-functional printer” in that it is an online “printer” that will print the submitted document as it would appear in its “finished” state; that is, the “finished” document printed by Virtual Builder will have the “look and feel” of the “actual” document); and
- the step of transmitting the document information includes transmitting document information to the MFP (as explained in the above rejection for Claim 1, the “document information” is transmitted to Virtual Builder).

Claim 3:

Blumberg discloses the method of Claim 1, wherein:

- the document information is Page Description Language (PDL) data (the “document information” is PDL data in that the document is created using a typical word processor); and

- the step of transmitting document information includes transmitting PDL data from the client to the printing device (as explained in the above rejection for Claim 1, the “document information” is transmitted to Virtual Builder).

Claim 4:

Blumberg discloses the method of Claim 1, wherein the step of generating preview document data at the printing device includes generating raster image data at the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device (Page 6, Paragraphs 0107-0110).

Claim 5:

Blumberg discloses the method of Claim 1, wherein the step of generating preview document data at the printing device includes generating a bitmap image at the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device (Page 9, Paragraphs 0184 and 0188).

Claim 6:

Blumberg discloses the method of Claim 1, wherein:

- the printing device is associated with one or more different paper characteristics that are available for printing electronic documents (Page 4, Paragraph 0068); and
- the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different paper characteristics that are available for printing electronic documents (Page 4, Paragraph 0068).

Claim 7:

Blumberg discloses the method of Claim 6, wherein the one or more different paper characteristics includes one or more paper type characteristics, wherein the one or more paper type characteristics indicate a specific type of paper that has been for printing the electronic document (Page 4, Paragraph 0068).

Claim 8:

Blumberg discloses the method of Claim 6, wherein the one or more different paper characteristics includes one or more paper color characteristics, wherein the one or more paper color characteristics indicate a specific color of paper that has been for printing the electronic document (Page 4, Paragraph 0068).

Claim 9:

Blumberg discloses the method of Claim 1, wherein:

- the printing device supports one or more different fonts that are available for printing electronic documents (Page 4, Paragraph 0174); and
- the set of one or more specific characteristics associated with the printing device includes one more of the one or more different fonts that are available for printing electronic documents (Page 4, Paragraph 0174).

Claim 10:

Blumberg discloses the method of Claim 1, wherein:

- the printing device is associated with one or more different stapling characteristics that are available for selection (Page 4, Paragraph 0071 and Page 10, Paragraph 0193); and
- the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different stapling characteristics that are available for selection (Page 4, Paragraph 0071 and Page 10, Paragraph 0193).

Claim 11:

Blumberg discloses the method of Claim 1, wherein:

- the printing device is associated with one or more different finishing characteristics that are available for selection (Page 4, Paragraphs 0064-0074); and

- the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different finishing characteristics that are available for selection (Page 4, Paragraphs 0064-0074).

Claim 12:

Blumberg discloses the method of Claim 1, wherein:

- the client includes a print driver that is associated with the printing device (the document is created using a word processor; all computers with word processors **inherently** have a print driver); and
- the set of one or more specific characteristics that are unavailable at the client includes one or more characteristics that are unknown to the print driver (Page 4, Paragraphs 0064-0074 – the “specific characteristics” unknown to the print driver include covers, paper types and bindings).

Claim 14:

Blumberg discloses the method of Claim 1, wherein:

- the step of generating preview document data at the printing device further includes the steps of determining the resolution of a display device that is associated with the client (Page 7, Paragraph 0138 and Page 9, Paragraph 0174); and
- generating the preview document data based on the resolution of the display device (Page 7, Paragraph 0138 and Page 9, Paragraph 0174).

Claim 15:

Blumberg discloses the method of Claim 1, wherein:

- the step of generating preview document data at the printing device includes the steps of generating two-dimensional (2-D) preview document data (see Figure 1); and
- the step of displaying the preview version of the electronic document includes the step of displaying portions of the electronic document at the client in 2-D (see Figure 1).

Claim 16:

Blumberg discloses the method of Claim 1, wherein:

- the step of generating preview document data at the printing device includes the steps of generating three-dimensional (3-D) preview document data (Page 10, Paragraph 0200 through Page 11, Paragraph 0210); and
- the step of displaying the preview version of the electronic document includes the step of displaying portions of the electronic document at the client in 3-D (Page 10, Paragraph 0200 through Page 11, Paragraph 0210).

Claim 17:

Blumberg discloses the method of Claim 1, wherein:

- the step of generating preview document data at the printing device includes the steps of generating HyperText Markup Language (HTML) data at the printing

- device (the reference discloses a client communicating with an online printer; thus, the “printing device” *inherently* “generates HTML data”); and
- the step of transmitting the preview document data to the client includes the step of transmitting the HTML data to the client from the printing device (the reference discloses a client communicating with an online printer; thus, the “printing device” *inherently* “transmits HTML data” to the client).

Claim 18:

Blumberg discloses the method of Claim 1, wherein:

- the step of generating preview document data at the printing device includes the steps of generating; Extensible Markup Language (XML) data at the printing device (Pages 3 and 4, Paragraph 0061); and
- the step of transmitting the preview document data to the client includes the step of transmitting the XML data to the client from the printing device (Pages 3 and 4, Paragraph 0061).

Claim 19:

Blumberg discloses a method for previewing an electronic document, the method comprising:

- receiving from a client at a printing device document information associated with an electronic document (see Figure 2; see Page 3, Paragraph 0058 through Page 6, Paragraph 0106 – the user imports the document into Virtual Builder;

thus, the referenced invention “transmits” “document information” to a “printing device”; Virtual Builder is a “printing device” in that it can be on a print server that is connected to a printer, as shown in Figure 2);

- generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device (Virtual Builder “generates” the specified “preview document data” as discussed in the rejection for Claim 1); and
- transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document (Virtual Builder “transmits” “preview document data” to display a “preview” on a “display unit” as discussed in the rejection for Claim 1).

Claim 20:

Blumberg discloses the method of Claim 19, wherein:

- the document information is Page Description Language (PDL) data; and
- the step of receiving document information includes receiving PDL data at the printing device (these limitations are disclosed by the prior art as discussed in the rejection for Claim 3).

Claim 21:

Blumberg discloses the method of Claim 19, wherein the step of generating preview document data at the printing device includes generating raster image data at

the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device (these limitations are disclosed by the prior art as discussed in the rejection for Claim 4).

Claim 22:

Blumberg discloses the method of Claim 19, wherein:

- the printing device is associated with one or more different paper characteristics that are available for printing electronic documents; and
- the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different paper characteristics that are available for printing electronic documents (these limitations are disclosed by the prior art as discussed in the rejection for Claim 6).

Claim 23:

Blumberg discloses the method of Claim 19, wherein:

- the printing device is associated with one or more different finishing characteristics that are available for selection; and
- the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different finishing characteristics that are available for selection (these limitations are disclosed by the prior art as discussed in the rejection for Claim 11).

Claim 24:

Blumberg discloses the method of Claim 19, wherein the step of generating preview document data at the printing device further includes the steps of:

- determining a display resolution of the display device that is associated with the client; and
- generating the preview document data based on the display resolution of the display device (these limitations are disclosed by the prior art as discussed in the rejection for Claim 14).

Claim 25:

Blumberg discloses the method of Claim 19, wherein:

- the step of generating preview document data at the printing device includes generating three-dimensional (3-D) preview document data; and
- the step of transmitting to the client the preview document data includes transmitting preview document data that causes the preview version of the electronic document to be displayed in 3-D on the display unit associated with the client (these limitations are disclosed by the prior art as discussed in the rejection for Claim 16).

Claims 26, 29-39 and 41-45:

Claims 26, 29-39 and 41-45 merely recite a computer-readable medium for performing the methods of Claims 1-12 and 14-18, respectively. Thus, Blumberg

discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 1-12 and 14-18.

Claim 27:

Blumberg discloses a system for previewing an electronic document (see Page 1, Paragraph 0009), comprising:

- one or more processors (see Page 2, Paragraph 0019 – Blumberg discloses this limitation in that the print preview system inherently has a processor because it involves a computer that “processes” electronic data to display the print preview of the document);
- one or more memories coupled to the one or more processors (see Page 2, Paragraph 0019 – Blumberg discloses this limitation in that the print preview system includes a memory that stores finishing options);
- one or more sequences of instructions stored in the one or more memories (see Figure 1; see Page 1, Paragraph 0010 – Blumberg discloses this limitation in that the print preview system includes software), wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:
 - receiving from a client at a printing device document information associated with an electronic document;

- generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device; and
- transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document (as indicated in the above rejection for Claim 19, Blumberg discloses all of the above limitations).

Claims 46-56 and 58-62:

Claims 46-56 and 58-62 correspond to Claims 1-12 and 14-18, respectively. Thus, Blumberg discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 1-12 and 14-18.

Claim 28:

Blumberg discloses a document preview apparatus (see Page 1, Paragraph 0009), comprising:

- a memory for storing characteristics that are associated with the document preview apparatus, wherein the characteristics are unavailable to clients that are connected to the document preview apparatus (see Page 3, Paragraph 0058 through Page 6, Paragraph 0106; see Page 2, Paragraph 0019 – Blumberg discloses this limitation in that the print preview system includes a memory

associated with Virtual Builder that stores finishing options not available at the client computer);

- one or more processors (see Page 2, Paragraph 0019 – Blumberg discloses this limitation in that the print preview system inherently has a processor because it involves a computer that “processes” electronic data to display the print preview of the document) that are configured for:
 - receiving from a client at a printing device document information associated with an electronic document;
 - generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device; and
 - transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document (as indicated in the above rejection for Claim 19, Blumberg discloses all of the above limitations).

Claims 63-69:

Claims 63-69 merely recite a computer-readable medium for performing the methods of Claims 19-25, respectively. Thus, Blumberg discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 19-25.

Claims 70-76:

Claims 70-76 merely recite a computer apparatus medium for performing the methods of Claims 19-25, respectively. Thus, Blumberg discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 19-25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 40 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg, in view of Bando, U.S. Patent No. 6,449,053.

Claim 13:

As indicated in the above discussion, Blumberg discloses every element of Claim 1. Blumberg also discloses a print driver that is associated with the printing device (as indicated in the rejection for Claim 12).

Blumberg fails to expressly disclose:

- a print driver is that associated with one or more print driver attributes that are not supported by the printing device; and

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- in the step of generating preview, document data at the printing device includes the step of translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device.

Bando teaches:

- a print driver is that associated with one or more print driver attributes that are not supported by the printing device (see Column 1, Line 13 through Column 2, Line 30 – the printing device does not support all fonts in the PDL); and
- translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device (see Column 1, Line 13 through Column 2, Line 30 – the RIP converts PDL into raster image data),

for the purpose printing documents on the print device and reducing the overall cost of the computer network (see Column 1, Lines 62-67).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Blumberg, to include:

- a print driver is that associated with one or more print driver attributes that are not supported by the printing device; and
- in the step of generating preview, document data at the printing device includes the step of translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device,

for the purpose printing documents on the print device and reducing the overall cost of the computer network, as taught by Bando.

Claim 40:

Claim 40 merely recites a computer-readable medium for performing the method of Claim 13. Thus, Blumberg, in view of Bando, discloses/teaches every limitation of this claim and is rejected using the same rationale discussed in the above rejection for Claim 13.

Claim 57:

Claim 57 merely recites a computer system for performing the method of Claim 13. Thus, Blumberg, in view of Bando, discloses/teaches every limitation of this claim and is rejected using the same rationale discussed in the above rejection for Claim 13.

Response to Arguments

Applicant's arguments filed 20 April 2004 have been fully considered but they are not persuasive.

Applicants arguments for Claim 1:

Applicant argues that Blumberg fails to disclose "generating preview document data at the printing device based on the document information and a set of one or more

specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client" because Virtual Builder generates "preview document data" on a client computer and/or a server computer that do not contain any printing capabilities. Thus, Applicant argues, the preview document is not generated at a "printing device" as recited in Claim 1. See *Applicant's Response* – Page 21, first full paragraph.

The examiner disagrees.

In Figure 2 of Blumberg, the Virtual Builder software is shown to be included on a print server. On Page 8, Lines 5-8 in the Specification of the present application, an example of a "printing device" is given – a multifunctional peripheral that includes . . . a server process. Thus, the Virtual Builder software is part of a "printing device," and the preview document is generated at a "printing device."

Applicants arguments for Claim 13:

Applicant argues that Bando fails to disclose "generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client" as recited in Claim 1. See *Applicant's Response* – Page 23, fourth paragraph through Page 24, first partial paragraph.

The examiner disagrees.

Applicant's argument is moot because the rejection is based on 35 U.S.C. 103 and the examiner does not use Bando to teach the specified limitation. Blumberg discloses the specified limitation, as indicated in the above discussion. Moreover, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

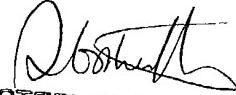
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
September 9, 2004



STEPHEN S. HONG
PRIMARY EXAMINER